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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,823	04/02/2001	Terry Thomas	7771-62	8090

7590

09/24/2003

Micheline Gravelle
Bereskin & Parr
Box 401
40 King Street West
Toronto, ON M5H 3Y2
CANADA

EXAMINER

SAUNDERS, DAVID A

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 09/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
822,823

Applicant(s)
THOMAS et al

Examiner
SAUNDERS

Group Art Unit
1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/23/03
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 21-26 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 21, 23-24, 26 is/are allowed.
- ☒ Claim(s) 22, 25 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

The amendment of 6/23/03 has been entered. Claims 21-26 are pending and under examination.

The amendment has overcome 112 and 102 rejections of record in the previous Office action.

The following 103 rejection of record is maintained.

Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al. (FASEB J. 2000) in view of Thomas et al. (6,117,985).

The combination of references was previously applied to claims 14-20, now cancelled. Presently this combination of references is cited against new claims 23 and 26, which have incorporated the subject matter taught in the references cited previously (Paper 8).

The previously stated rejection explained how the references teach the CD45, CD 66b and CD 36 antigens were known to be on undesired cells and how they teach the glycophorin-A antigen was known to be on erythrocytes. The rejection provided motivation for combining the references.

Applicant has traversed the rejection by arguing that provisional application 60/193,371, filed 3/31/00, supports the instant claims. The examiner concurs that Table 9 from said application supports instant claims 21, 23-24 and 26; these have not been rejected; claims 22 and 25, however, are not supported by application 60/193,371; there is nothing therein that points out the subcombination of these three particular antigens as being of interest. Therefore

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the instant claims reciting this combination are not supported. As previously stated (Paper 8, page 5), original claims 15 and 18 were only granted benefit of the instant CIP filing date; Instant claims 22 and 25 correspond in content to original claims 15 and 18 and are thus presently rejected. It is noted that while Thomas et al. show CD45, CD66^b and CD36 as members of a taught laundry list, rather than as a particularly preferred subcombination of these antigens, citation is proper because the claims recite "comprising".

Applicant has also urged that, even if the instant claims, were not granted benefit of the 3-31-00 filing date of application 60/193,371, the Peters et al. reference is not applicable because the disclosure therein is inventor derived. This statement (page 9) is mere a attorney pleading and not evidence. To establish derivation on the record, there must be affidavits/declarations by the other authors indicating that the relevant portions of the publication originated with, or were obtained from, the applicant. MPEP 2132.01.

Applicant's urgings filed 6/23/03 have been considered but are unconvincing of patentability.

In response to the examiner's query regarding public sale, applicant submitted a reference (Peter et al., Proceedings of the American Association for Cancer Research vol. 41, page 589, March 2000). This reference will not be cited, as was Peters et al. (FASEB Jour., April 2000), because the reference has an authorship identical to the instant inventorship.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, Ph.D., whose telephone number is (703) 308-3976. The examiner can normally be reached on Monday - Thursday from 8:00 a.m. to 5:30 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

D. Saunders:jmr
September 10, 2003

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
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